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ZURITA, JAMES H

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/925,519
Filing Date: August 10, 2001
Appellant(s): CHIARABINI ET AL.

MAILED

SEP 10 2007

GROUP 3600

David S. Thompson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 16 May 2007 appealing from the Office action mailed 3 January 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

Claims 10, 28-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Blumberg et al. (PG-PUB 2003/0140315), filed 7 June 1999.

As per claim 10, Blumberg discloses providing on-line print services:
receiving at least one order for print products on-line

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for example, receiving print orders at vendors, as in paragraphs 6-8

said at least one order having an item requiring a particular sheet material

for example, printing materials (paragraph 0123) including paper, as in paragraphs 9, 27-30, 123. see also references to business cards, type of paper, grain, weight, size, color

electronically distributing said at least one order to at least one print service

provider facility

for example, paragraph 42, routing to in-house print center or external service providers. See also paragraph 117, concerning routing a job to appropriate print service providers. See also references to distributing print orders to available printers at reproduction centers and other print facilities, as in paragraph 147. See also references to distributing print orders to local and remote production centers, as in paragraph 151

within said print service provider facility, **electronically allocating** said item to a

printer device

for example, prioritizing and routing orders, as jobs to one or more printer devices at the centers, at paragraph 151. Please note that orders are orders for specific items, requiring specific sheet materials. see at least paragraph 132, concerning targeting specific output device such as a color printer

based on said printer device having said particular sheet material loaded on said

printer device

For example, See paragraph 105, 172, for printer devices that print on materials such as paper, clay (mugs), cloth, woven fabric (t-shirts), business cards, paragraph 0169. see also specific sheet materials, as in paragraph 0028.

printing said item according to said order

for example, paragraph 116, which discloses tracking a job progress as it proceeds through the workflow. See also paragraph 117 concerning actions that take place after a job is completed. See also references to delivery, billing and payment for ordered print products, paragraph 116.

with said printer device, and on said particular sheet material.

to fill an order for t-shirts or business cards (as disclosed in paragraph 0172), a print device must have the specified sheet material on the specified (targeted, as in paragraph 0146, resource availability, as in paragraph 152)

Blumberg discloses allocating a plurality of said print items to a plurality of printer devices, taking into account for each printer device, parameters selected from the set: availability of said printer device; a sheet material type loaded onto said printer device; an ink type loaded onto said printer device; a percentage utilization of said printer device. See, for example, at least references to routing to particular printer devices based on job type and resource availability, as in paragraph 0152.

As per claim 28, Blumberg discloses that electronically distributing is based on said at least one print service provider facility being capable of printing on said particular sheet material. For example, paper, as in paragraph 0009, fabric for t-shirts and other sheet materials, as in paragraph 0172, targeting specific output device such as a color printer, paragraph 0028, laminating items that have already been printed by a printer device, paragraph 9.

As per claim 29, Blumberg discloses electronically arranging a plurality of virtual print items on at least one virtual media sheet and re-sorting said plurality of virtual print items amongst said at least one virtual media sheet in a manner which minimizes a number of cuts applied to said at least one virtual media sheet. See for example, references to paragraph 96. See also references to printing eight-page booklets on a single large page, thereby minimizing the number of cuts to the virtual media sheet.

As per claim 30, Blumberg discloses electronically allocating a print item to a printer device further based on a percentage utilization of said printer device, interpreted in light of not appealed rejection of 35 USC 112. See references to available printers, as in paragraph 147.

Claim 27 is rejected under 35 U.S.C.103(a) as unpatentable over Blumberg, above, in view of admitted prior art (previously Officially Noticed).

Appellants' pre-KSR brief argues that there is no teaching suggestion or motivation to combine Blumberg with prior art (previously Officially Noticed). KSR forecloses Appellant's argument that a specific teaching is required for a finding of obviousness. KSR, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Claim 27 recites combinations which only unite old elements with no change in their respective functions and which yield predictable results. Thus, the claimed subject matter likely would have been obvious under KSR. In addition, neither Appellants' Specification nor Appellants' arguments present any evidence that modifying Blumberg and prior art was uniquely challenging or difficult for one of ordinary skill in the art.

Under those circumstances, the Examiner did not err in holding that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Blumberg to include printing print items on particular sheet material such as canvas, a woven fabric.

Because this is a case where the improvements are no more than the predictable use of prior art elements according to their established functions, no further analysis is required by the Examiner. KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 20030140315 A1

BLUMBERG et al.

07-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

(10) Response to Argument

Appellant argues that the Office has not established that Blumberg anticipates claims 1, 28-30, Brief at 5-16

As to claim 10, pages 5-10, Appellant argues that Blumberg only discloses viewing printed items on a monitor and does not disclose printer devices.

...the cited portions of [Blumberg] fail to disclose all of the elements of Applicant's claim...the above-cited text does not disclose...Instead, these passages relate to... software... which allows products to be viewed on a monitor. According to these passages, this software may include...[Blumberg reference]... cannot be shown to disclose...[parsed limitation]. Brief at 9, emphasis added.

Furthermore, as these passages fail to disclose "allocating [an] item to a printer device", they accordingly fail to disclose "electronically allocating said item to a printer device based on said printer device having said particular sheet material loaded on said printer device", Brief at 9, emphasis added.

...only relates to "display engines", which function on a user's computer monitor and do not relate to "electronically allocating" to a "print service provider facility being capable of printing on said particular sheet material" [Brief, at 12].

First, Appellant admits that Blumberg discloses creating and finishing printed items after the items are printed (by a printer device) based on sheet material in a device, emphasis added:

...Applicant respectfully submits, however, that lamination [...] is ...a finishing process that may be done upon a sheet material, Brief at 12 [Ex. Note: the process occurs after it has been printed by a printer device].

...[Blumberg discloses]...printing eight-page booklets on a single large page, thereby minimizing the number of cuts to the virtual media sheet...Brief, at 14.

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...these passages...disclose that an eight-page brochure may be created by a Virtual Builder user, viewed on the user's computer monitor, ordered by the user, and **produced by printing** on and folding a page three times. Brief at 15.

Blumberg discloses one way in which an eight-page booklet can be produced--namely printing on a large page and folding it three times...Blumberg intends to give the Virtual Builder software user the ability to create a booklet in a way which is "easy to implement". Brief at 16.

Second, Appellant relies on selected portions of Blumberg. The Examiner cites particular paragraphs, columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. See MPEP:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference...elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required...[MPEP 2131.01, emphasis added]

It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Third, Blumberg discloses the claimed features. A printed item, is, by definition, printed [past tense]. Blumberg discloses placing orders, payment for orders, finishing instructions and delivery of the printed items (as in paragraph 0032).

A particular example includes accepting print items (e.g., business cards), with selected indicia (templates) and specific attributes such as templates company address, logo. The cards are printed (by a printer device) on particular sheet material (e.g. selected paper type, size, grain, and other selected options).

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As to Claim 28, pages 10-12, Appellant argues that Blumberg **does not** disclose

electronically distributing is based on said at least one print service provider facility being capable of printing on said particular sheet material..." [emphasis added]

First, Appellant appears to contradict himself by admitting that Blumberg discloses finishing of printed items after the print items have been printed on sheet materials

...lamination [paragraphs 0009, 0028, for example] is ...a finishing process that may be done upon a sheet material. Brief, at 12.

Second, Blumberg discloses print items such as business cards and their indicia (attributes), as in paragraph 0169. For particular sheet material, see, for example, particular sheet material such as paper, as in paragraph 0009, fabric, as in t-shirts, paragraph 0173. See at least paragraph 0042 for routing to a print provider facility, that is capable of printing on particular sheet material such as paper.

As to claim 29, pages 13-16, Appellant argues that Blumberg **does not** disclose:

- electronically arranging a plurality of virtual print items on at least one virtual media sheet; and
- re-sorting said plurality of virtual print items amongst said at least one virtual media sheet in a manner which minimizes a number of cuts applied to said at least one virtual media sheet.

The Examiner notes the following:

- Appellant provides no definition for the terms [electronically] arrang[-ing] and re-sort-ing. Appellant refers to [electronically] arrang[-ing] and re-sorting...according to a [specific] algorithm:

15...electronically arranging ... virtual print items ...; and re-sorting ... virtual print items ... according to a sorting algorithm.

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16...electronically arranging... virtual print items ... ; and re-sorting ... virtual print items ... according to a backtracking algorithm.

17...electronically arranging ... virtual print items...; and re-sorting ... in a manner [unnamed algorithm] which minimizes a number of cuts applied to said at least one virtual media sheet.

- Appellant refers to "...number of cuts...[by] a human operator..." para. 0051, 0091, 0093 of Appellant's PG-PUB 20020026379A1. The term relates to Fig. 11, step 1105 (Minimize manual cutting) and is illustrated in Fig. 12.
- Since appellant has provided no explicit definition for the terms, the Examiner relies on the term's ordinary meaning and broadest reasonable interpretation. *E-Pass Technologies, Inc. v. 3Com Corporation*, 343 F.3d 1364, 1368, 67 USPQ2d 1947, 1949 (Fed. Cir. 2003). The Examiner interprets

electronically arranging ... virtual print items ...; and re-sorting...[to]...minimize a number of cuts...

as

electronically arranging... virtual print items...; and again [re-] electronically arranging according to characteristics [sorting]...[to] minimize a number of cuts...

- Blumberg discloses cutting and arranging print items on a single page:

[0102] Preferably, the library of available styles is based on a selected print facility, since different print facilities typically offer different selections of styles. Use of templates enables a user to create documents with sophisticated styles, without having to create the style himself. In addition, the styles of templates are preferably designed in such a way that they conform to printing and folding operations that are easy to implement. For example, an eight-page booklet can be produced by printing on a single large page that is folded in half three times, cutting appropriate folds and stapling twice in the center. In distinction, when a user designs his own style of document, it may be complicated to produce.
- The Examiner also notes that Appellant contradicts himself and appears to agree with the Examiner's interpretation:

...[Blumberg discloses]...printing eight-page booklets on a single large page, thereby minimizing the number of cuts to the virtual media sheet... Brief, at 14.

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...[Blumberg...disclose[s] that an eight-page brochure may be created by a Virtual Builder user, viewed on the user's computer monitor, ordered by the user, and produced by printing on and folding a page three times... Brief at 15.

...Blumberg discloses one way in which an eight-page booklet can be produced--namely printing on a large page and folding it three times...

... Blumberg [...gives...] the Virtual Builder software user the ability to create a booklet in a way which is "easy to implement". Brief at 16.

Therefore, Appellant's arguments are not persuasive.

Appellant argues that rejection of claim 27 under 35 U.S.C. §103(a) fail to establish that Blumberg in view of Official Notice renders claim 27 obvious.

Appellant argues, page 16,

Claim 27 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Blumberg in view of Official Notice. Claim 27, however, depends from claim 10. Because the "Official Notice" does not cure the deficiencies of the rejection of claim 10, the rejection of claim 27 is improper for least the reasons discussed above in regards to the base claim. Furthermore, claim 27 recites features that are not properly disclosed by the cited portions of Blumberg or by proper Official Notice.

In response, a "traverse" is a denial of an opposing party's allegations of fact.¹

The Examiner respectfully submits that applicants' arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 706.07(a). An adequate traverse must contain adequate information or argument to create on its

¹ Definition of Traverse, Black's Law Dictionary, "In common law pleading, a traverse signifies a denial."

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face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). MPEP 2144.03 Reliance on Common Knowledge in the Art or "Well Known" Prior Art. In view of applicant's failure to adequately traverse official notice, the following is admitted prior art::

It is old and well known to print on sheet materials such as cloth and other types of materials, including canvas.

Blumberg discloses customized print items that are printed by printer devices on particular sheet materials such as paper and fabric (t-shirts, a collarless short-sleeved or sleeveless, usually cotton undershirt). Blumberg does not mention canvas, a cloth of linen, hemp or cotton.

As now admitted prior art, it is old and well known to print on sheet materials such as cloth and other types of materials, including canvas. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Blumberg and general knowledge to disclose that particular sheet material is canvas. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Blumberg and general knowledge to disclose that particular sheet material is canvas for the obvious reason that marketing products such as printed canvas bags, for example, may help to promote a company's image.


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Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

James Zurita
Primary Examiner
Art Unit 3625
31 August 2007


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